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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,594	05/03/2001	Sujal Bhalakia	589.063US2	8703
37374	7590	02/20/2004	EXAMINER	
INSKEEP INTELLECTUAL PROPERTY GROUP, INC 1225 W. 190TH STREET SUITE 205 GARDENA, CA 90248			ZACHARIA, RAMSEY E	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,594

Applicant(s)

BHALAKIA ET AL.

Examiner

Ramsey Zacharia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-79 is/are pending in the application.
- 4a) Of the above claim(s) 59-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

2. Claims 59-79 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the response filed 10 March 2003.

Claim Rejections - 35 USC § 102

3. Claims 50-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawaki et al. (U.S. Patent 5,051,309).

Kawaki et al. teach a polarizing plate comprising a polarizing polymeric film (i.e. a functional layer) and polycarbonate plates (i.e. first and second resinous layers) bonded to both surfaces of the polymeric film (column 2, lines 22-29). The polymeric film may be made of polyvinyl alcohol (column 3, lines 24-29). The plates are bonded to the film using acrylic-type, epoxy-type, or urethane-type adhesives (column 3, lines 51-59). In the embodiment of Example 1, the polarizing plate has a thickness of about 1.5 mm (2 x 0.7 mm + thickness of PVOH film which is about 20-120 μ m (see column 3, lines 51-56)) was used as a lens and was molded to have radius of curvature of 90 mm. Therefore, this plate will have a generally round shape

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(since it is a lens) and would substantially conform to the back surface of an injected molded lens having a radius of curvature of 90 mm.

The adhesives used by Kawaki et al. are taken to inherently have sufficient flexibility so as to substantially prevent crazing during molding, substantially prevent yellowing, and minimize shrinkage during cure since they appear to be the same adhesives used in the instant application (i.e. acrylic-type, epoxy-type, or urethane-type adhesives).

Regarding claims 55 and 56, the limitations of these claims are directed to the type of molded lens that the laminate is to be used to make. However, the claims are directed to a laminate and not a molded lens. As such, limitations drawn to the molded lens are directed to the intended use of the laminate and not structural limitations of the laminate itself. Since it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations (see *Ex parte Masham*, 2 USPQ2d 1647 (1987)), the laminate of Kawaki et al. is taken to meet the limitations of claims 55 and 56.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawaki et al. (U.S. Patent 5,051,309) in view of Guglielmetti et al. (U.S. Patent 5,631,720).

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Kawaki et al. teach all the limitations of claim 58, as outlined above, except for the use of a photochromatic layer as the functional layer.

Guglielmetti et al. teach a photochromic compound that may be incorporated into a polymer for use in sunglasses (column 6, lines 8-13). Polyvinyl alcohol is a suitable polymer to which the photochromic compound may be added (column 6, lines 14-20). The photochromic compounds are used to screen out light radiation according to its intensity (column 1, lines 20-25 and column 2, lines 19-37).

One of ordinary skill in the art would be motivated to add the photochromic compound of Guglielmetti et al. to the polyvinyl alcohol layer of Kawaki et al. to yield sunglasses that are not only polarized but that also darken when exposed to intense light.

Response to Arguments

6. Applicant's arguments filed 02 December 2003 have been fully considered but they are not persuasive.

The applicants argue that Kawaki et al. do not disclose a laminate for use in making an injection molded eye lens, but rather a laminate for use only as goggles, sunglasses, windshields, etc. Furthermore, the applicants argue that Kawaki et al. do not disclose any dimensions of the center thickness of the laminate as found on the injection molded lens.

This is not persuasive because the elected claims are drawn to a laminate and not an injection molded eye lens. While the laminate is intended to be used for making an injection molded eye lens, the claimed invention is merely a laminate not an injection molded eye lens. The manner in which the laminate is intended to be used (e.g. for making goggles as opposed to

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injection molded eye lens) does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations.

The applicants argue that Kawaki et al. do not disclose that their laminate has a generally round shape nor that it is dimensioned so as to substantially conform to a back surface of an injection molded eye lens.

This is not persuasive because the laminate of Kawaki et al. is used as a lens in sunglasses and goggles. As such it will have a generally round shape. Moreover, the laminate is also molded to impart a particular radius of curvature. This meets the limitation "dimensioned so as to substantially conform to a back surface of said injection molded eye lens" since the eye lens in this limitation is a hypothetical lens that the laminate is intended to be used to make. The lens itself is not positively recited in the claim, so the limitation is met if the laminate is dimensioned so that it would substantially conform to a lens, regardless of whether or not there is an actual lens present. A laminate that has a particular radius of curvature (e.g. 90 mm) would substantially conform to the back surface of an injection molded eye lens having a similar radius of curvature.

Regarding claims 55 and 56, the applicants disagree that these claims do not recite structural limitations for the laminate because it is known that there are significant differences between an injection molded lens with prescription power and one without.

While the examiner concedes that there is a difference between an injection molded lens with prescription power and an injection molded lens without prescription power, the claims are drawn to a laminate and not an injection molded lens. Therefore, there is no injection molded lens, with or without prescription power, in the claimed article.

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Finally, the applicant argues that the Kawaki et al. reference does not give any criticality to the type of adhesive used in formulating the laminate in contrast to the instant invention that requires the adhesive to be sufficiently flexible to prevent crazing when the laminate is used as an injection molded lens.

This is not persuasive because the adhesive used by Kawaki et al. (i.e. an adhesive of the "acrylic type, epoxy type or urethane type" see column 3, lines 59) appears identical to that used in the instant invention (see page 18, line 22 of the instant specification). Flexibility is a material property and since the material used as an adhesive by Kawaki et al. appears to be the same as that used in the instant invention, it should have the same flexibility.

The rejection of claims 1-56 and 58 as anticipated by Gulati et al. has been withdrawn because Gulati et al. is directed to the use of a glass functional (i.e. photochromic) layer as opposed to a polymeric layer.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (571) 272-1516. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ramsey Zacharia
Primary Examiner
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